

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-5, 8, and 9 are pending in this application. Claims 6 and 7 are canceled by the present response without prejudice. Claims 1, 5, 8, and 9 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. patent 6,175,548 to Kashiwagi. Claims 5, 6, and 9 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. patent 6,125,101 to Kikukawa et al. (herein “Kikukawa”). Claims 1, 2, 5, 8, and 9 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. patent 6,449,239 to Uno et al. (herein “Uno”). Claim 3 was rejected under 35 U.S.C. § 103(a) as unpatentable over either Uno or Kashiwagi in view of Kikukawa. Claims 4 and 7 were objected to as dependent upon a rejected base claim, but were noted as allowable if rewritten in independent form to include all of the limitations of their base claim and any intervening claims.

Applicants gratefully acknowledge the indication of the allowable subject matter in claims 4 and 7.

Addressing first the rejection of claims 1, 5, 8, and 9 under 35 U.S.C. § 102(e) as anticipated by Kashiwagi, that rejection is traversed by the present response.

Initially, applicants note claim 1 is amended by the present response to clarify that “the grooves are located relatively closer to a plane through which the laser beam enters than the lands”.

According to such a claimed structure, and with reference to Figures 1 and 2 in the present specification as a non-limiting example, an optical recording medium includes grooves 2G and lands 2L. As shown in those figures, and as noted in the specification at page 4, lines 13-24, the grooves 2G are regions located relatively closer to a laser incident surface, whereas the lands 2L are regions located relatively more remote from the laser incident surface. Kashiwagi does not disclose such a structure.

Kashiwagi discloses the use of pits or grooves 13. However, in Kashiwagi the laser is transmitted through light transmission layer 12, and thereby in Kashiwagi the pits or grooves 13 are *further away* from the plane through which the laser beam enters than the lands. Thus, Kashiwagi discloses a structure directly contrary to claim 1.

One basis for maintaining the outstanding rejection indicates that the previously submitted arguments were not convincing to address the rejection as the “claimed invention does not recite whether a groove is located relatively closer to a laser incident surface or not”.¹ In response to that position applicants note independent claim 1 now clearly recites such a feature.

One further basis for the outstanding rejection also stated “Applicant’s attention is drawn to a land on the recording medium of [Kashiwagi] which is interpreted as a groove as recited in the claimed invention”.²

The above-noted basis for the outstanding rejection is not at all understood as Kashiwagi itself makes it clear that element 13 is a recording pit or a groove, see for example Kashiwagi at column 3, lines 13-14. Thus, Kashiwagi could not reasonably be interpreted by one of ordinary skill in the art such that element 13 was not a groove but was instead a land.

In such ways, amended independent claim 1, and the claims dependent therefrom, are believed to clearly distinguish over Kashiwagi.

Addressing now the rejection of claims 5, 6, and 9 under 35 U.S.C. § 102(b) as anticipated by Kikukawa, that rejection is traversed by the present response.

Independent claim 5 is amended by the present response to incorporate all the limitations from previously pending dependent claim 7, and intermediate claim 6. Thus, amended independent claim 5 corresponds to previously pending dependent claim 7 rewritten in independent form. That subject matter was noted as allowable in the outstanding Office

¹ Office Action of November 15, 2005, page 6, prenumbered paragraph 8.

² Office Action of November 15, 2005, page 6, prenumbered paragraph 8.

Action. Thus, amended independent claim 5, and claim 9 dependent therefrom, are believed to be allowable and the rejection over Kikukawa is traversed by the present response.

Addressing now the rejection of claims 1, 2, 5, 8, and 9 under 35 U.S.C. § 102(e) as anticipated by Uno, that rejection is traversed by the response.

Independent claim 1 recites “recording being carried out in a groove recording mode, in which only the grooves serve as a recording track”. Applicants submit that feature is not taught or suggested by Uno. Uno does not refer to recording in a groove recording mode exclusively.

The only basis for addressing the above-noted feature in claim 1 stated in the Office Action with respect to the teachings in Uno is “(Note: grooves serve as a recording track only when recording is performed on the grooves)”.³

In response to that basis for the outstanding rejection applicants note Uno does not disclose at any portion a groove recording mode in which only grooves serve as a recording track. Applicants also note the Office Action has not cited any disclosure in Uno to disclose such a feature. Thereby, claims 1, 2, and 8 are believed to clearly distinguish over Uno.

Claims 5 and 9 also are believed to clearly distinguish over Uno in view of claim 5 incorporating the subject matter from allowable dependent claim 7.

Addressing now the rejection of claim 3 under 35 U.S.C. § 103(a) as unpatentable over either Uno or Kashiwagi in view of Kikukawa, that rejection is also traversed by the present response.

Each of the primary references to Uno and Kashiwagi are deficient for reasons discussed above, and Kikukawa cannot cure those deficiencies. Thus, dependent claim 3 is also believed to be allowable.

³ Office Action of November 15, 2005, page 4, last two lines.

In view of these foregoing comments, applicants respectfully submit the claims as currently written distinguish over the applied art.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

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